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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,628

10/17/2003

David Scott Jones

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EXAMINER

LOFTUS, ANN E

ART UNIT

PAPER NUMBER

3692

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/686,628	Applicant(s) JONES, DAVID SCOTT	
	Examiner ANN LOFTUS	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/17/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/17/04, 2/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This is the first action on the merits to an application filed on 10/17/03. Claims 1-31 are pending. No continuation or provisional is claimed.

Claim Objections

2. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The test for a proper dependent claim is whether the dependent claim could possibly be infringed by anything which would not also infringe the parent claim. In this case, mere possession of a readable carrier configured to be readable to execute instructions would infringe the dependent claim, while the method would not necessarily be executed, thus infringement of the parent claim is not inherent. In this case, the claim appears to not require the instructions for claim 1 to be stored.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:
"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

4. Claims 29-31 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 29, 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). This claims embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. Claim 1 begins by discussing a method. Claim 29 is to a system, which is an apparatus. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

As to claims 30 and 31, these claims are directed towards signals and programs, neither of which is in a statutory category. Categories that are patentable by statute include process, manufacture, machine or composition of matter. The carrier wave is not a static medium, but merely a form of energy, and as such is not patentable in itself. A computer program is considered to be nonfunctional descriptive material unless it is claimed to be stored as executable instructions on a physical medium (not a carrier wave). Note that the claim must go beyond the capability or possibility to positively recite that the instructions are stored.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 29, it is unclear what statutory class is intended. Is the claim a method or an apparatus? The metes and bounds are unclear.

As to claims 29 and 31, the word "carrier" is troublesome because of the carrier wave problem addressed above.

As to claims 1, 15, 30 and 31, the term "payment product" is unclear. What constitutes a payment product?

As to claims 1, 15, 30 and 31, the last phrase, "wherein the payment processing system and the mail facility are local" is not clear. The term "local" is a relative term which renders the claim indefinite. How close is local? What do they need to be close to? The term "local" is not defined by the claim, the specification does not provide a standard for determining the required degree of localness, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The metes and bounds of the claim are unclear.

As to claims 13 and 27, the negative limitation "not sent into a regular mail channel" is unclear. Regular is a relative term, and there is no standard for determining the required degree of regularity. The examiner is unclear as to which mail channels are regular and which are not. Is Fedex regular? Further, what is a mail item that is not sent by mail? How is this related to the payment product?

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5-8, 10-13, 15, 17, 19-22, 24-27, 29, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 2003/0200107 filed 8/8/02 by Allen (provisional 3/13/02.)\

As to claims 1, 15, 29, 30 and 31, Allen teaches receiving a mail item comprising a payment product at a mail facility and identifying a routing code associated with the mail item and routing the mail item to a payment processing system based at least in part on the routing code (paragraph 41 - 42 page 3). The examiner interprets a mail facility to include a facility that receives mail. Allen teaches at the payment processing system extracting the payment product from the mail item (paragraph 97 page 7)..Allen teaches wherein the payment processing system and the mail facility are local (paragraph 52 page 4 and fig 3, which shows the mail facility receiving and extracting mail collocated with payment processing).

Allen teaches electronically transmitting payment data associated with the payment product to an intended recipient for processing (image forwarded to collection processor) and destroying the payment product at the payment processing system (paragraph 95 page 7) but this is in a slightly different embodiment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the

first embodiment to add electronically transmitting payment data associated with the payment product to an intended recipient for processing and destroying the payment product at the payment processing system in order to avoid the cost and delay of securely moving paper checks.

As to claims 3 and 17, Allen teaches a routing code comprised of a Post Office Box identifier in paragraph 41 page 3.

As to claims 5 and 19, Allen teaches the payment processing system is located at the mail facility (paragraph 52 page 4 and fig 3, which shows the mail facility receiving and extracting mail collocated with payment processing).

As to claims 6, 7, 20 and 21, Allen teaches the payment data comprises a portion of the payment product that is scanned for electronic transmission (image forwarded to collection processor, paragraph 95 page 7).

As to claims 8 and 22, Allen teaches the coupon scanned in claim 16, and displayed with the payment product in Fig 9 and paragraph 124 page 9. A person of ordinary skill in the art at the time of the invention would understand that the coupon and check were transmitted from the payment service center scanner to the collection processor where the images are displayed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to make explicit a payment product electronically transmitted with items associated with the payment product in order to reduce tracking and shipping paper and also to keep the coupon and check information together for easy reference.

As to claims 10, 11, 24 and 25, Allen teaches a recipient (collection processor) determining a payment type (acceptable vs returns) based on the payment data, and determines an appropriate clearing path, in page 4 paragraph 62. See also paragraph 83 page 6.

As to claims 12 and 26, Allen teaches ACH in paragraph 53 page 4 and truncating checks in paragraph 108 page 8. A person of ordinary skill in the art at the time of the invention would understand truncating to mean replacing the physical check with an image replacement document to send via image exchange channels.

As to claims 13 and 27, Allen teaches an item not sent into regular mail (ACH) in paragraph 53 page 4.

9. Claims 2, 4, 9, 14, 16, 18, 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Official Notice.

As to claims 2 and 16, Allen does not explicitly teach a zip code. Official Notice is taken that it is old and well-known to route mail with a zip code. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add a routing code comprising a zip code in order to make use of a code that is familiar to participants.

As to claims 4 and 18, Allen does not explicitly teach routing codes comprised of numbers and letters. Official Notice is taken that it is old and well-known to use codes comprised of letters and numbers. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add a routing code

comprising letters and numbers because it would give a greater number of possible code values for a given length code to use both.

As to claims 14 and 28, Allen teaches checks and money orders and other payment instruments in the abstract, and corporate and consumer checks in paragraph 118 page 9. Allen does not explicitly teach cashier checks. Official notice is taken that these are old and well-known methods of payment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add cashier checks in order to be compatible with contemporary payment forms.

As to claims 9 and 23, Allen teaches scanning a payment coupon in claim 16. Allen teaches scanned correspondence pages in Fig 9 and paragraph 124 page 9. Allen teaches electronically transmitting the check as above. Allen refers to information associated with the check, but does not explicitly teach remittance advice, a statement nor accounts receivable data. Official Notice is taken that this is data commonly associated with a payment. It could have been scanned, transmitted and displayed as correspondence. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to explicitly add remittance advice, a statement and accounts receivable data in order to keep associated information with the check data for easy reference.

Conclusion

10. While portions of interest have been indicated, all references should be considered for the entirety of their teachings.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

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